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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/828,673	04/21/2004	Michael M. French	EMER 2632.1 (E-2455)	4475
28997	7590	07/11/2006	EXAMINER	
HARNESS, DICKEY, & PIERCE, P.L.C			CHAN, KO HUNG	
7700 BONHOMME, STE 400			ART UNIT	
ST. LOUIS, MO 63105			PAPER NUMBER	
			3632	

DATE MAILED: 07/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/828,673

Applicant(s)

FRENCH, MICHAEL M.

Examiner

Korie H. Chan

Art Unit

3632

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 25 April 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |                                                                                                                        |                                                                                         |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                                                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____                                                |

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

***Claim Rejections - 35 USC § 102***

Claims 1, 5-7, 9-11 stand rejected under 35 U.S.C. 102(b) as being anticipated by Ashe, Jr. et al (US patent no. 6,664,681). Ashe discloses a system for fastening a dynamoelectric machine (80) to a mount (110), the system comprising: a dynamoelectric machine (80) having two opposite ends, one of the ends comprising a mounting end having at least one fastener hole (100) extending therethrough; and a fastener insert (120) secured in the at least one fastener hole on the mounting end, the fastener insert having a bore (160) with internal threads for receiving a threaded fastener (108) to fasten the dynamoelectric machine to the mount; wherein the dynamoelectric machine includes a motor housing comprising two attached members (86, 88) formed of stamped steel (Col. 2, line 53); wherein the fastener hole in the mounting end and the fastener insert have corresponding circular shapes (figure 1); wherein there are four fastener holes (figure 1) in the mounting end and four corresponding fastener inserts; further comprising the threaded fastener, the fastener comprising a machine screw having a shank (186) and a head (172); wherein the mount comprising a portion of a grill (110) having a hole (180) for receiving the fastener.

***Claim Rejections - 35 USC § 103***

Claims 2-4 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Ashe, Jr. et al (US patent no. 6,664,681) in view of "Spin Tite Fasteners" as provided by

applicant. Ashe disclosed all the claimed features of applicant's invention except for the insert of the type having a crimped portion defining a gap. Insert of the type having a crimped portion defining a gap is old and well-known as demonstrated by Spin Tite. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have substituted the Ashe's insert with the insert of Spin Tite. Such modification would have involved a mere substitution of one well-known insert for another which is thought to be well within the ambit of one of ordinary skill in the art.

Claim 8 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Ashe, Jr. et al (US patent no. 6,664,681). Ashe disclosed all the claimed features of applicant's invention except for the insert and hole having a polygonal shapes. Such would have been an obvious matter of design choice since applicant does not disclose such shapes solves the stated problem or more advantages over other shapes. Moreover, it appears that circular hole and insert would perform as well.

Claims 12-14 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Ashe, Jr. et al (US patent no. 6,664,681) in view of Janisse (US patent no. 5,002,462). Ashe disclosed all the claimed features of applicant's invention except for the grill hole having a recess for head of fastener with a slot extend from hole for rotatably mounting the machine to the grill mount. Janisse teaches a motor mount comprising a motor (30) having four fasteners (31, figure 3) mounted to a grill (9) having holes (41) for receiving fasteners and recess (the recess is formed between the two inner rings on which the plate 42, figure 9 with hole 41 is mounted thereto) for the head of the fastener with a slot (43, figure 9) extending therefrom for rotatably mounting the machine to the

grill mount. It would have been obvious to one of ordinary skilled in the art to have modify the grill of Ashe, Jr. such that keyholes are provided for the grill to facillate quick mount of the motor or machine to the grill as taught to be desirable by Janisse.

### ***Response to Arguments***

Applicant's arguments filed 4/25/2006 have been fully considered but they are not persuasive. Applicant argues that Ashe, Jr. does not have a fastener insert with preformed internal threads but rather the Ashe's threads are formed by the screw tightening into the insert or clinch nut 120. Applicant's recitation of "preformed internal threads" is a product-by-process recitation. In such product by process recitation, the process has no patentability weight. As stated in MPEP 2113, "Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." In re Thorpe, 777 F.2d 695,698,227 USPQ 964, 966 (Fed. Cir. 1985). In this Ashe Jr. demonstrates the same product (insert with internal threads for receiving threaded fastener). The threads are indeed made by the fastener 108 the first time it engages the insert (120). However, in the scenario, when the fastener (108) is removed for reassembly, the threads on the self-clinch nut previously formed the first time by the fastener (108) would be preformed when the fastener reengages the nut or insert (120). Thus the rejection stands.

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Korie H. Chan whose telephone number is 571-272-6816. The examiner can normally be reached on Monday - Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Chilcot can be reached on (571)272-6777. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3632

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Korie H. Chan  
Primary Examiner  
Art Unit 3632

khc  
July 7, 2006